



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Am

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,685	02/13/2001	Roy Hays	181138002US1	9957

7590 06/27/2005

LINIAK, BERENATO & WHITE LLC
6550 ROCK SPRING DRIVE
SUITE 240
BETHESDA, MD 20817

EXAMINER

TRAN, PHILIP B

ART UNIT PAPER NUMBER

2155

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,685

Applicant(s)

HAYS ET AL.

Examiner

Philip B. Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/22/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendments

Notice to Applicant

1. This communication is in response to the amendment filed 22 November 2004. Claims 1 and 6-7 have been amended, however, applicant has not indicated that claim 7 has been amended. Claims 10-13 have been newly added. Therefore, claims 1-13 are pending for further examination.

37 CFR 1.131 Affidavit

2. Applicant has submitted an affidavit on 22 November 2004 to remove Bluth (U.S. Pat. No. 6,403,897). This affidavit is defective because the examiner has never applied Bluth (U.S. Pat. No. 6,403,897) as a reference in the previous office action. Instead, the examiner did apply Bluth (U.S. Pat. No. 6,692,436), another patent issued to the mentioned inventor and filed on the same date of 14 April 2000, as a reference in the office action dated 20 May 2004. Assuming that applicant has made a typographical error and thus assuming that applicant has submitted an affidavit to remove Bluth (U.S. Pat. No. 6,692,436) (hereafter, Bluth reference) as a reference applied by the examiner in the previous office action. The affidavit filed on 22 November 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Bluth reference for the following reasons:

The affidavit includes exhibits 1-6, thereby alleging conception, diligence, and reduction to practice of the instant invention prior to the filing date of the Bluth reference.

(A) The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Bluth reference.

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See **Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897)**.

In the affidavit and remarks filed on 22 November 2004, applicant provides the claimed limitations and corresponding modules' names and files' names. However, the examiner respectfully submits that it is not clear how the modules' names and files' names teach applicant's claimed invention. Providing modules' names and files' names only shows a vague idea and thus lacks support in the submitted evidence to establish a conception of the claimed invention.

(B) The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Bluth reference to either a constructive reduction to practice or an actual reduction to practice.

What is meant by diligence is brought out in **Christie v. Seybold, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893)**. In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible

explanations for delay or inactivity. See **In re Nelson**, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See **MPEP § 2138.06** for a detailed discussion of the diligence requirement for proving prior invention. Under **37 CFR 1.131**, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under **37 CFR 1.131**. See **Ex parte Merz**, 75 USPQ 296 (Bd. App. 1947).

An applicant must account for the entire period during which diligence is required. **Gould v. Schawlow**, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); **In re Harry**, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. **In re Mulder**, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); **Fitzgerald v. Arbib**, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice).

In the affidavit and remarks filed on 22 November 2004, applicant provides the claimed limitations and corresponding modules' names and files' names. However, the examiner respectfully submits that it is not clear how the modules' names and files' names teach applicant's claimed invention. Applicant has not provided any of the software code to indicate that the invention was actually reduced to practice. The examiner notes that it appears from Exhibits 5 and 6 that there was a period of inactivity. In addition, the examiner also notes that it appears from Exhibits 5 and 6 that applicant was continuing to update the programs after the filing date of the Bluth reference. It does not appear the invention was reduced to practice as of the filing date of the Bluth reference. Applicant must then show due diligence from before the Bluth reference until an actual reduction to practice or constructive reduction to practice. In this case, applicant has failed to provide this evidence to establish diligence from a date prior to the date of reduction to practice of the Bluth reference to either a constructive reduction to practice or an actual reduction to practice.

Thus, the affidavit filed on 22 November 2004 is deemed insufficient to remove Bluth reference as prior art.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 3-13 are rejected under 35 U.S.C. § 102(e) as being anticipated by Bluth et al (Hereafter, Bluth), U.S. Pat. No. 6,692,436.

Regarding claim 1, Bluth teaches a method in a computer system for distributing user information for registered users from the computer system to collection kiosks (= health information system for tracking of users' health information and storing health information in the local health information kiosks (110) or health information server (104) for later retrieval) [see Abstract and Col. 4, Lines 17-33], the method comprising:

providing user information for registered users, the user information comprising medical information specific to the registered users (= upon identification of users by usage of PIN number or ID card, providing users for accessing to health services and information including blood pressure history) [see Col. 13, Lines 7-17];

receiving updates to the user information and generating update user information (= receiving information and generating a user blood pressure history by retrieving the first and the subsequent measurement of user blood pressure) [see Fig. 12B and Col. 4, Lines 20-23 and Col. 9, Lines 1-35 and Col. 19, Line 58 to Col. 20, Line 50]; and

for each of the collection kiosks (= health information kiosks (110)) [see Fig. 1],
receiving a request from the collection kiosk for the generated update user information and sending to the requesting collection kiosk the update user information

(= requesting for health services and information and providing access to health services and information) [see Col. 2, Lines 25-50 and Col. 18, Lines 20-62]; and storing the updated user information at the requesting collection kiosk for subsequent requests, wherein the collection kiosks use the update user information to verify whether a user is registered (= storing and categorizing data from a user according to identification number and upon identification of a user by usage of PIN number or ID card then a user can retrieve records from previous tests) [see Col. 6, Lines 30-45 and Col. 13, Lines 7-34 and Col. 13, Lines 54-59 and Col. 18, Lines 20-62].

Regarding claim 3, Bluth further teaches the received update user information includes indications of whether to add a registered user, delete a registered user, or change information relating to a registered user (= upon identification of users by usage of PIN number or ID card, providing users for accessing to health services and information including blood pressure history) [see Col. 13, Lines 7-17 and Col. 19, Line 58 to Col. 20, Line 50].

Regarding claim 4, Bluth further teach a collection kiosk sends a request for the generated update user information once a day (= loading information from many users and all information generated on the health information kiosks (110) to the central health information server (104) on a daily basis for maintaining accurate and current information available to users) [see Bluth, Col. 4, Lines 23-33].

Regarding claim 5, Bluth further teaches the user information includes a user identifier and a password (= accessing the user's blood pressure history by entering access number such as a password, a PIN number or the like) [see Col. 13, Lines 7-25].

Regarding claim 6, Bluth teaches a method in a collection kiosk for retrieving updated user information (= health information system for tracking of and retrieving users' health information including blood pressure history) [see Abstract and Col. 4, Lines 17-33]:

providing user information for registered users, the user information comprising medical information specific to the registered users (= upon identification of users by usage of PIN number or ID card, providing users for accessing to health services and information including blood pressure history) [see Col. 13, Lines 7-17];

sending a request for updated user information and in response to sending the request, receiving the updated user information (= requesting for health services and information and providing access to health services and information) [see Col. 2, Lines 25-50 and Col. 18, Lines 20-62]; and

updating the provided user information for the registered user in accordance with the received updated user information so that the collection kiosk can verify whether a user of the collection kiosk is registered (= receiving information and generating a user blood pressure history by retrieving the first and the subsequent measurement of user blood pressure using PIN number or ID card) [see Fig. 12B and Col. 9, Lines 1-35 and Col. 13, Lines 7-34 and Col. 19, Line 58 to Col. 20, Line 50]; and

storing the updated user information at the collection kiosk for subsequent requests (= storing and categorizing data from a user according to identification number and upon identification of a user by usage of PIN number or ID card then a user can retrieve records from previous tests) [see Col. 6, Lines 30-45 and Col. 13, Lines 7-34 and Col. 13, Lines 54-59 and Col. 18, Lines 20-62].

Regarding claim 7, Bluth teaches an information collection system (= health information system) [see Abstract] comprising:

a central computer system for a web site (= health information server (104)), the central computer system providing a repository for the information (= storage of personal history information) [see Col. 4, Lines 23-28 and Col. 5, Lines 51-54], registering users of the web site (= registration form with a web site) [see Fig. 17 and Col. 14, Lines 18-21], and accessing the information (= for users accessing information) [see Col. 5, Lines 51-54]; and

a plurality of collection kiosks (= health information kiosks (110)) [see Fig. 1] for collecting information about users (= maintaining a local archive of user information) [see Col. 4, Lines 1-5], for verifying whether a user is registered at the web site (= verifying user by authentication with access ID number and password) [see Col. 13, Lines 10-32], and for sending the collected information to the central computer system when the user is registered (= loading information from many users and all information generated on the health information kiosks (110) to the central health information server (104)) [see Col. 4, Lines 23-29].

Regarding claim 8, Bluth further teaches the information is medical information (= tracking of health reading including blood pressure, heart rate and weight) [see Col. 4, Lines 17-18].

Regarding claim 9, Bluth teaches a computer-based method for collecting medical information of users of a web site (= health information system for tracking of health reading including blood pressure, heart rate and weight) [see Abstract and Col. 4, Lines 17-18], the method comprising:

registering the users at the web site when information about a user is collected at one of a plurality of collection kiosks, determining whether the user is registered at the website (= registration form with a web site [see Fig. 17 and Col. 14, Lines 18-21] wherein verifying user by authentication with access ID number and password [see Col. 13, Lines 10-32]); and

when registered, sending the collected information to a computer system so that the collected information is accessible to the user through the web site (= loading information from many users and all information generated on the health information kiosks (110) to the central health information server (104) [see Col. 4, Lines 23-29] wherein users can access information via the Internet [see Col. 5, Lines 51-54]).

Regarding claim 10, Bluth further teaches a collection kiosk automatically sends a request for the generated update user information periodically (= loading information from many users and all information generated on the health information kiosks (110) to

the central health information server (104) on a daily basis for maintaining accurate and current information available to users) [see Bluth, Col. 4, Lines 23-33].

Regarding claim 11, Bluth further teaches sending a request for updated information is automatic and performed periodically (= loading information from many users and all information generated on the health information kiosks (110) to the central health information server (104) on a daily basis for maintaining accurate and current information available to users) [see Bluth, Col. 4, Lines 23-33].

Regarding claim 12, Bluth further teaches sending a request for updated information is automatic and performed daily (= loading information from many users and all information generated on the health information kiosks (110) to the central health information server (104) on a daily basis for maintaining accurate and current information available to users) [see Bluth, Col. 4, Lines 23-33].

Regarding claim 13, Bluth further teaches the information comprising medical information specific to the registered users (= upon identification of users by usage of PIN number or ID card, providing users for accessing to health services and information including blood pressure history) [see Col. 13, Lines 7-17] and the central computer system further is for receiving updates to the user information from the collection kiosks and generating update user information (= receiving information and generating a user blood pressure history by retrieving the first and the subsequent measurement of user

blood pressure) [see Fig. 12B and Col. 4, Lines 20-23 and Col. 9, Lines 1-35 and Col. 19, Line 58 to Col. 20, Line 50], and for each of the collection kiosks (= health information kiosks (110)) [see Fig. 1], receiving a request from the collection kiosk for the generated update user information and sending to the requesting collection kiosk the update user information (= requesting for health services and information and providing access to health services and information) [see Col. 2, Lines 25-50 and Col. 18, Lines 20-62].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bluth et al (Hereafter, Bluth) U.S. Pat. No. 6,692,436 in view of McMillan, U.S. Pat. No. 5,826,267.

Regarding claim 2, Bluth does not explicitly teach the collection kiosks operate as FTP clients and the computer system operates as an FTP server.

However, McMillan, in the same field of client-server architecture with information kiosk endeavor, discloses the use of File Transfer Protocol (FTP) known as one of Internet client/server protocol [see McMillan, Col. 2, Lines 1-15]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the implementation of File Transfer Protocol (FTP), disclosed by McMillan, into the system of registry information to collect information from kiosks for storing in the central server disclosed by Bluth, in order to enable the user to efficiently upload and download files to and from a remote FTP site over the network such as the Internet.

Response to Arguments

7. Applicant's amendment necessitates the change of new grounds of rejections. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment to the specification including headings, sub-headings and summary of invention has been entered.

9. Applicant's arguments regarding the Hensley Declaration have been considered. Applicant appears to rely on the affidavit evidence that is ineffective to remove the Bluth reference for the reasons given above, and thus the Bluth reference is still appropriate for applying in rejections.

Other References Cited

10. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

- A) Hinkle, U.S. Pat. No. 6,190,313.
- B) Teller et al, U.S. Pat. No. 6,605,038.
- C) Surwit et al, U.S. Pat. No. 6,024,699.
- D) Martin et al, U.S. Pat. No. 6,484,144.
- E) Lion, U.S. Pat. No. 6,330,491.
- F) McGauley et al, U.S. Pat. No. 5,899,998.

Conclusion

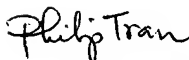
11. Applicants' amendment necessitates the change of new grounds of rejections.

Accordingly, THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (703) 872-9306. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Philip B. Tran
Art Unit 2155
June 15, 2005